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Paper No. 44

WORLDCOM, INC.
TECHNOLOGY LAW DEPARTMENT
1133 19TH STREET NW
WASHINGTON, DC 20036

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APR 07 2004

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OFFICE OF PETITIONS

In re Application of : DECISION REFUSING STATUS
Barry, et al. : UNDER 37 CFR 1.47(a)
Application No. 09/159,695 :
Filed: September 24, 1998 :
Atty. Dkt.: COS-97-087 :
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This decision is in response to the petition under 37 CFR 1.47(a), filed December 12, 2003.

The petition under 37 CFR 1.47(a) is hereby DISMISSED.

The above-identified application was filed September 24, 1998. An executed declaration names B. Barry, M. Chodoronek, E. Derose, M. Gonzales, A. James, L. Levy, and M. Tusa as joint inventors. Petitioner herein seeks to correct the inventive entity of this application to add inventor C. Devine as a joint inventor.

The first executed oath or declaration filed establishes the inventive entity of an application. Moreover, the provisions of 37 CFR 1.47 are only applicable to original oaths or declarations. Further, the provisions of 37 CFR 1.47 may not be utilized for the purposes of correcting an error in inventorship made without deceptive intent. See, 37 CFR 1.41(a)(1), 37 CFR 48(f)(1), and MPEP 201.03.

Wherein an original executed oath or declaration has been submitted and it is later determined that the original executed oath or declaration failed to set forth the correct inventive entity and this error in inventorship was made without deceptive intent, a petition under 37 CFR 1.48 may be filed. A petition under 37 CFR 1.47 filed in conjunction with a petition under 37 CFR 1.48 would be appropriate wherein an inventor that was not named in the original executed oath or declaration refuses to execute the amended oath or declaration in accordance with 37 CFR 1.63.

The provisions of 37 CFR 1.47 cannot be utilized for the purposes of correcting an error in inventorship in an original executed oath or declaration wherein an inventor that executed the original oath or declaration thereafter refuses to sign or cannot be located to sign the amended oath or declaration. See, MPEP 201.03(B) for further guidance.

A fully executed declaration exists in the instant application. Accordingly, a petition under 37 CFR 1.47(a) is deemed inappropriate and subject to dismissal. No further consideration under the provisions of 37 CFR 1.47 will be forthcoming.

Petitioner is advised to submit a petition under 37 CFR 1.48 to add an inventor to the application. The inventorship of an application may be amended under the provisions of 37 CFR 1.48. If the inventive entity is set forth in error in an oath or declaration executed under to 37 CFR 1.63 and the error arose without any deceptive intent on the part of the person named as an inventor in error or on the part the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors.

Correction of inventorship pursuant to 37 CFR 1.48(a) requires the following: (1) a request to correct the inventorship that sets forth the desired inventorship change; (2) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (3) an oath or declaration by the actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR §§ 1.42, 1.43 or 1.47; (4) the processing fee set forth in 37 CFR 1.17(I); and (5) if an assignment has been executed by any of the original inventors, the written consent of the assignee.

The petition under 37 CFR 1.48 should be accompanied by a petition under 37 CFR 1.183, if deemed appropriate, requesting waiver of the requirements of 37 CFR 1.48(a)(3). A petition under 37 CFR 1.183 must be accompanied by the required petition fee and an oath or declaration complying with 37 CFR 1.63. The available inventor(s) should execute the oath or declaration. A petition under 37 CFR 1.183 should include sufficient evidence that the non-signing inventor(s) is indeed unavailable after diligent efforts to locate him and present the declaration, or, after having sufficient time and access to the application papers (specification, including claims, drawings, and oath or declaration), the request under Rule 48 made to the inventor(s).

failed. See, MPEP 201.03(b) and MPEP 201.03(c). Petitioner may wish to incorporate by reference the facts and circumstances outlined in the instant petition in the petition under 37 CFR 1.183.

Petitioner is given **TWO (2) MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Renewed Petition," and should only address the deficiencies noted herein. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition
Commissioner for Patents
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Alexandria, VA 22313-1450

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(703) 872-9306

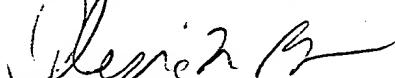
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Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0310.



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